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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,629	02/06/2001	Yoshio Sugimoto	1046.1238 (JDH)	7168
21171	7590	05/06/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			BARQADLE, YASIN M	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/776,629	SUGIMOTO, YOSHIO	
	Examiner	Art Unit	
	Yasin M. Barqadle	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on October 25, 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The amendment filed on October 25, 2004 has been fully considered but are not deemed to be persuasive.

- Claims 1-21 have been amended.
- Claims 1-21 are presented for examination.

Response to Amendment

2. In response to applicant's arguments in pages 9-10, that Bailey does not teach, "storing "unread/already read information" Examiner notes that Bailey teaches a storage unit 34, fig. 2 for storing a message application such as the well known electronic messaging application of Microsoft Exchange that holds unread/already read messages. A list of unread/already ready messages is displayed on list pane 50 (col. 3, lines 60 to col. 4, lines 7 and col. 4, lines 33-56). Applicant also argues that Bailey does not teach "holding a state of 'unread,' which is determined on the basis of the unread/already read information" Examiner notes that Bailey teaches a method for distinguishing between read and unread messages by using visual indications consisting of boldface text, italics, highlight colors, or a flag based on if the

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message was read or not read by the user (col. 4, lines 45-52
and col. 5, lines 16-32).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claims 1-6, 8-13 and 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey et al USPN (5835084).

As per claim 1, Bailey et al teach a device for reading electronic mails (device 10, fig. 2), comprising:

a storing unit storing unread/already-read information corresponding to each of received electronic mails [storage 34, stores received unread email messages addressed (received) to a user col. 3, lines 60-67 and col. 4, lines 33-56];

a holding unit holding a state of "unread", which is determined on the basis of the unread/already-read information of an electronic mail at a predetermined timing [window pane hold a list of unread/already-read message. Email messages are organized and mark as read or unread col. 3, lines 60-67; col. 4, lines 45-52 and col. 5, lines 10-32]; and

a controller controlling a management of reading of the electronic mail setting the state of "unread" managed by said holding unit [a processor executes a method for distinguishing between read and unread messages col. 5, lines 15-38].

As per claim 2, Bailey et al teach the device according to claim 1, wherein said storing unit stores the state of "unread" or a

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state of "already-read" of a corresponding electronic mail as the unread/already-read information [col. 5, lines 10-23],

said holding unit holds a list with which each electronic mail with the state of unread stored in said storing unit at the predetermined timing is registered [col. 5, lines 10-32]; and

said controller executes a process for displaying a registered electronic mail in said list on a display according to a request for reading the registered electronic mail [col. 3, lines 60 to col. 4, line 56 and col. 5, lines 1-14].

As per claim 3, Bailey et al teach the device according to claim 2, wherein said controller specifies the mail corresponding to the request by use of said list, and displays a body of the specified electronic mail on said display [fig. 4 and col. 5, lines 1-23].

As per claim 4, Bailey et al teach the device according to claim 1, further comprising a display controller displaying a screen for searching the electronic mail managed by said holding unit on said display [fig. 3; col. 3, lines 60 to col. 4, lines 7 and col. 5, lines 1-23].

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As per claim 5, Bailey et al teach the device according to claim 4, wherein said list holds information of the plurality of registered electronic mails in predetermined sort order [fig. 3, col. 4, lines 33-44];

a pointer is set at any one of the information in said list [fig. 3, and col. 4, lines 45-52]; and

said display controller displays the screen for searching an electronic mail registered next to the registered electronic mail corresponding to the information pointed by the pointer and/or a previous electronic mail of the registered electronic mail corresponding to the information pointed by the pointer [fig. 3, and col. 4, lines 45-52 and col. 6, lines 21-26].

As per claim 6, Bailey et al teach the device according to claim 1, wherein the predetermined timing is a time point of which reading the body of the electronic mail is requested [col. 4, lines 24-65].

As per claims 8 and 15, these are a storage medium and method claims with similar limitations as claim 1 above. Therefore, they are rejected with the same rationale. See the rejection of Claim 1 above.

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As per claims 9 and 16, Bailey et al teach the invention wherein said storing stores the state of "unread" or a state "already-read" of a corresponding electronic mail as the unread/already-read information [col. 5, lines 10-32],

said holding holds a list which each electronic mail with the state of "unread" is registered [col. 5, lines 10-32]; and

said controlling step executes a process for displaying a registered electronic mail in said list on a display according to a request for reading the registered electronic mail [a processor executes a method for distinguishing between read and unread messages col. 5, lines 15-38].

As per claims 10 and 17, Bailey et al teach the invention wherein said controlling specifies the mail corresponding to the request by use of said list, and displays a body of the specified electronic mail on said display [fig. 4 and col. 5, lines 1-23].

As per claims 11 and 18, Bailey et al teach the invention, further comprising displaying a screen for searching the electronic mail with the held state of "unread" on said display [A list of unread/already ready messages is displayed on list

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pane 50 col. 3, lines 60 to col. 4, lines 7 and col. 4, lines 33-56. See fig. 3 and col. 5, lines 1-23].

As per claims 12 and 19, these claims have similar limitations as claim 5 above. Therefore, they are rejected with the same rationale. See the rejection of Claim 5 above.

As per claim 13 and 20, Bailey et al teach the invention, wherein the predetermined timing is a time point of which reading the body of the electronic mail is requested [col. 4, lines 24-65].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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4. Claims 7,14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al USPN (5835084) in view of Kudoh et al USPN (5948058).

As per claims 7, 14 and 21, although Bailey et al shows substantial features of the claimed invention including a message window with icon buttons enabling a user to store, reply, forward and print message, he does not explicitly show deleting message list on the basis of a request for an end (end command) for reading an electronic mail. Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Bailey et al, as evidenced by Kudoh et al USPN (5948058).

In analogous art, Kudoh et al whose invention is about a system for cataloging and displaying emails, disclose deleting a message list (category of a classified electronic mail) on the basis of a request for an end of reading the electronic mail by a user [Col. 28, lines 48 to col. 29, line 13]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Bailey to support mechanism of deleting a list of electronic mails for the flexibility of displaying electronic messages on a desktop and the advantage of improving storage space.

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Conclusion

5. **ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be

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reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Yasin Barqadle

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